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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,417	06/09/1999	MANUEL A. CORREA JR		6806

7590 06/24/2002

Mr. Manuel Correa  
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EXAMINER

COSIMANO, EDWARD R

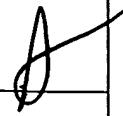
ART UNIT

PAPER NUMBER

3629

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/328,417	CORREA JR, MANUEL A. 
	Examiner Edward R. Cosimano	Art Unit 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 6/9/99, 5/22/00 & 5/15/02.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 82-109 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 82-109 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 June 1999 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3,4,14</u>	6) <input type="checkbox"/> Other: _____

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.
- 2.1 The oath or declaration is defective because:
  - A) as submitted the declaration lacks the top margin required by 37 CFR § 1.52(a)(1)(ii).
3. The drawings are objected to because:
  - A) the following errors have been noted in the drawings:
    - (1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
      - (a) 900 as described in the paragraph between page 22, line 19, and page 23, line 2, "Figure 9 is a block diagram ... screened area 900 ... is formed in reply envelope 30.".
- 3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
4. The disclosure is objected to because of the following informalities:
  - A) as required by 37 CFR § 1.84(p)(5) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 881 & 882 of fig. 8 as fig. 8 is described in the paragraph at page 22, lines 5-18, "Figure 8 also depicts flap 880, ... of reply envelope 30 along with an edge 886.";

(b) 1010 of fig. 10 as fig. 10 is described in the paragraph at page 23, lines 3-10, "Figure 10 is a block diagram ... 880 mentioned above in conjunction with Figure 8.";

In this regard, it is noted that merely mentioning a number without mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75; § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1 Claims 82, 85, 90-95, 97 & 104-109 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Fabel (4,461,661).

6.1 In regard to claims 82, 85, 90-95, 97 & 104-109, Fabel ('661), which discloses a mailing comprised of a number of attached layers/plies with selective carbon spotting to the multiple layers/plies in order to selectively transfer information applied to the top layer to underlying layers and wherein (1) two of the layers are combined to form the mailing

envelope, and (2) any suitable weight/bond of paper may be used for each layer. Further a tear strip is used to aid the recipient in opening the mailing.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 83, 84, 86-88, 96 & 98-101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel (4,461,661) as applied to above claims 82, 85, 90-95, 97 & 104-109 and further in view of an obvious modification based on applicant's admitted prior art.

7.1.1 In regard to claims 83, 84, 87 & 98-100, since applicant admits that:

(1) the Post Office requires a 90% readability of applied barcodes (see the last full paragraph of page 3);

(2) the Post Office provides discounts for the application of information such as postal barcodes and facer identification marks (FIM) to items of mail (see the first full paragraph of page 2 and the paragraph bridging pages 2-3);

(3) the Post Office uses optical character recognition (OCR) and barcode readers (BCR) to scan information applied to a mailing (see the paragraph bridging pages 1-2); and

(4) the machines used by the Post Office to sort mail sometimes smears the applied barcodes so that the barcode is illegible, (see second full paragraph on page 1, "The present invention ... smeared by the post office processing equipment."); it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of Fabel ('661) were to apply barcodes to the out going and return envelopes to obtain a postal discount, then the applied barcodes and FIMs would be placed on the envelopes at a location which:

- (1) may be read by the equipment used by the Post Office;
- (2) is protected from being made illegible by the equipment used by the Post Office; and
- (3) has suitable contrast with the background color of the mailing so as to aid in the recognition of the barcode.

7.1.2 In regard to claims 99 & 100, it is noted that since Fabel ('661) discloses that the use of FIMs reduces the associated postage costs, it would have been obvious to one of ordinary skill at the time the invention was made that the FIM applied to the out going envelope could be also applied to the return envelope using the transfer process of Fabel ('661).

7.1.3 In regard to claims 86, 88 & 89, since Fabel ('661) explicitly suggests:

- A) the need to use paper with sufficient weight/bond in order to obtain the desired result of the system of Fabel ('661); and
- B) the layers/plies of the mailing are bonded together;

it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of Fabel ('661) would use any suitable bonding means and weight/bond of paper to form each layer/ply of the item of mailing so as to form a complete mailing that is suitable for reaching the recipient and accomplishing the purpose of returning reply of recipient to the original sender.

7.1.4 In regard to claim 96, since Fabel ('661) explicitly suggests using a tear strip to aid the recipient in opening the mailing, it would have been obvious to one of ordinary skill at the time the invention was made that the tear strip of the system of Fabel ('661) could be placed in any suitable location on the mailing so that the mailing may reach the recipient intact.

7.2 Claims 102-103 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel (4,461,661) as applied above to claims 82, 85, 90-95, 97 & 104-109 and further in view of an obvious modification.

7.2.1 In regard to the use of a security screed in claims 102-103, since it is conceivable that the user of the mailer of Fabel ('661) would use the mailer to send confidential mail, it would have been obvious to one of ordinary skill at the time the invention was made that the mailer of Fabel ('661) could be modified to use security screens so as to prevent unauthorized reading of confidential information applied to the mailer of Fabel ('661).

8. The examiner has cited prior art of interest, for example:

A) Sherman (2,257,766), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers.

B) Johnsen (3,837,565), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers, where some of the layers contain instructions on how to open the mailing.

C) the British Business article, which discloses all of the components of a mailing must fit together.

D) either Bendel (EP 354758 A1 or 5,161,735), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers and wherein a layer may be folded to form the mailing envelope and wherein postal barcodes are applied to the mailing envelope. Bendel (EP 354758 A1) is a family member of Bendel (5,161,735) and is cited for the same disclosure of Bendel (5,161,735).

E) either Chess (5,253,803 or EP 586061 A1), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers and wherein two of the layers are combined to form the mailing and return envelopes. Chess (EP 586061

A1) is a family member of Chess (5,253,803) and is cited for the same disclosure of Chess (5,253,803).

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (703) 746-7240.

10.2 The fax phone number for **OFFICIAL FAXES** is (703) 305-7687.

10.3 The fax phone number for **AFTER FINAL FAXES** is (703) 308-3691.

06/16/02

*Edward Cosimano*  
Edward R. Cosimano  
Primary Examiner A.U. 3629